

### **REMARKS**

This amendment is in response to the May 16, 2011 non-final Office action. Claim 56 has been canceled; thus claims 1-55 and 57-62 are pending and stand rejected. Applicants respectfully maintain that the claims are patentable over the cited art as amended above and discussed below.

### **Claim Objections**

Claim 37 stands objected to due to an inadvertent typographical error. This error has been corrected as suggested in the Office action.

Claims 38-39 have been objected to, as the subject matter following the phrase “programming the digital computer to...” allegedly is considered intended use. Applicants respectfully traverse this objection, as each of these claims is directed to a “method for making a digital computer system.” The language following the phrase quoted above is not intended use, but rather describes the manner in which the computer is programmed in order to make the claimed digital computer system. As such, the limitations following this phrase are not language that “suggests or makes optional,” i.e., they are *not* intended use, but instead are required steps to be performed. MPEP § 2106.

For at least these reasons, Applicants request withdrawal of the claim objections.

### **35 U.S.C. § 112**

Claims 1, 8, 36, 38-43, and 55 stand rejected as allegedly failing to comply with the written description requirement of Section 112, ¶ 2 due to use of the translational phrase “consisting of.” The Office action alleges that there is no support for this phrase but admits that support exists for the broader, open-ended transitional phrase “comprising,” Office action at 3. Applicants respectfully maintain that if there is support for the broader phrase “comprising,”

then, by definition, support exists for a narrower phrase, i.e., “consisting of.” As such, Applicants respectfully request withdrawal of this Section 112 rejection.

Claims 37, 38, and 40 further stand rejected under Section 112 as allegedly indefinite due to the phrase “a digital computer and data processing system comprising a digital computer....” In response, these claims have been amended to claim “a data processing system comprising a digital computer.” In view of this amendment, Applicants respectfully request withdrawal of this Section 112 rejection.

Claim 56 allegedly is indefinite for several reasons relating to different types of expenses described in the claims. Claim 56 has been canceled, mooted this Section 112 rejection.

### **35 U.S.C. § 103**

#### **Independent claim 1**

Claims 1-5, 7-9, 11, 36, 38-41, 43-47, 49-52, and 54 stand rejected under Section 103 as allegedly obvious over U.S. Patent 6,386,444 to Sullivan in view of U.S. Patent 6,578,011 to Forward. Claims 6 and 10 stand rejected over Sullivan in view of Forward and U.S. Patent 6,751,596 to Hastings. Claims 12-22, 25-26, 28-35, and 57-62 stand rejected over Sullivan in view of Forward and U.S. Patent 6,999,943 to Johnson, et al. Claims 23-24 and 27 stand rejected over Sullivan in view of Forward and U.S. Patent 4,722,554 to Pettit. Claims 37 and 48 stand rejected over Sullivan in view of Forward and U.S. Patent 6,778,968 to Gulati. Claims 42, 53, and 55 stand rejected over Sullivan in view of U.S. Patent 7,076,455 to Fogelson.

Independent claim 1 claims a method including the step of associating input data representing card activity with further input data representing an external mortgage expense of a group consisting of a number of options. The Office action admits that Sullivan does not disclose this element but attempts to reach a conclusion of obviousness by citing Forward for this

alleged disclosure. Applicants respectfully maintain that the prior art does not disclose or render claim 1 obvious for at least three reasons.

Firstly, Sullivan expressly teaches away from the proposed modification. Instead of associating input data representing card activity with an external mortgage expense, Sullivan teaches rebating a portion of consumer spending to the payment of insurance premiums. *See* Sullivan, abstract. The proposed modification would require Sullivan to *not* associate card activity data with the insurance premium expense, but this would deprive insurance companies of this “mechanism for loyalty- or affinity-building,” *id.*, col. 2, l. 12, and of the “mechanism to channel funds back to insurance companies to expand business and cross-sell,” *id.*, col. 2, ll. 25-26, a consequence that Sullivan teaches would be a “lost opportunity,” *id.*, col. 2, l. 27, and a “significant disadvantage,” *id.*, col. 2, ll. 14, 27 (emphasis added). According to MPEP § 2142, “[k]nowledge of applicant’s disclosure *must be put aside*” in analyzing a claim for alleged obviousness. Without the benefit of Applicants’ disclosure, it would not have been obvious to modify Sullivan as suggested by the Office action, since Sullivan expressly discourages the proposed modification. MPEP § 2141.02 (“prior art reference must be considered *in its entirety*, i.e., as a *whole*, including portions that would lead away from the claimed invention”) (emphasis added), *citing W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983); MPEP § 2143.01 (proposed modification cannot render prior art unsatisfactory for its intended purpose), *citing In re Gordon*, 733 F.3d 900 (Fed. Cir. 1984).

Secondly, claim 1 requires associating data representing card activity with data representing an external residential mortgage expense. The Office action admits that Sullivan does not disclose this element and cites Forward for the alleged disclosure, but Forward discloses a system where an incentive (the alleged “external residential mortgage expense”) is provided to

a buyer if an item is purchased from a designated seller. *See* Forward, abstract. If the buyer purchases the item from a different seller, the incentive is not obtained. Additionally, the buyer's other purchases are not correlated to the incentive. Thus, Forward does *not* disclose associating data *representing card activity* with data representing an external residential mortgage expense, so the cited art, singly or in combination, fails to disclose all of the elements of claim 1.

Thirdly, Applicants respectfully maintain that Sullivan and Forward are non-analogous art. *See* MPEP § 2141.01(a) (“to rely on a reference under 35 U.S.C. 103, it must be analogous prior art”). Sullivan, classified in class/subclass 235/379, discloses a system and method for providing a rebate based on card payments, regardless of where the buyer makes purchases. *See* Sullivan, abstract. Conversely, Forward, classified in class/subclass 705/14, discloses a commission-based system designed to entice a buyer to a specific seller and nobody else. *See* Forward, abstract. Thus, the references represent different fields of endeavor and, because of the differences, Forward logically would not “have commended itself to an inventor’s attention in considering his or her invention as a whole.” MPEP § 2141.01(a), citing *KSR International Co. v Teleflex*, 550 U.S. 398 (2007).

For at least the foregoing reasons, Applicants respectfully maintain that the cited art, singly or in combination, neither discloses nor would have made obvious claim 1 and, therefore, respectfully request reconsideration and allowance of claim 1 and all claims that depend therefrom.

**Independent claims 8, 36, 37, 38, 39, 40, 41 and 43**

Independent claims 8, 36, 37, 38, 39, 40, 41, and 43 each stand rejected as allegedly obvious over at least the combination of Sullivan and Forward, i.e., the same combination of references cited against claim 1. Each of these claims includes the same or similar limitations to

those discussed above with respect to claim 1 and, as such, the rationale provided with respect to claim 1 establishes that the cited art neither discloses nor would have made obvious each of these independent claims. Applicants, therefore, respectfully request reconsideration and allowance of independent claims 8, 36, 37, 38, 39, 40, 41, and 43 and all claims that depend therefrom.

**Independent claims 42 and 55**

Independent claims 42 and 55 stand rejected as allegedly obvious over Sullivan in view of Fogelson. Each of these claims includes limitations similar to those discussed above with respect to claim 1 and, as such, the teaching away argument of Sullivan provided with respect to claim 1 similarly applies to these claims. (The Office action also discusses an “associating” step with respect to claim 42, but claim 42 contains no such limitation.) Additionally, Fogelson is similar to Forward in that an incentive is provided to a buyer if an item is purchased from a designated seller. *See* Fogelson, abstract. If the buyer purchases the item from a different seller, the incentive is not obtained. Additionally, the buyer’s other purchases are not correlated to the incentive. Thus, like Forward, Fogelson does *not* disclose crediting card activity to an expense payment, as claimed in claim 42, or associating card activity with residential expenses, as claimed in claim 55. Applicants, therefore, respectfully maintain that the cited art, singly or in combination, fails to disclose all of the elements of claims 42 and 55 and request reconsideration and allowance of these claims and all claims that depend therefrom.

**Dependent claims 5 and 9**

Claims 5 and 9, which depend from claims 1 and 8, respectively, are allowable for at least the reasons provided with respect to those independent claims. In addition, claims 5 and 9 require the expense be a closing cost or the applying step include producing a closing cost, respectively. The Office action alleges that Sullivan discloses these elements at col. 6, ll. 38-50,

but that portion of Sullivan discloses only that multiple types of insurance policies may be offered, e.g., whole life insurance, term life insurance, etc. No part of the cited portion of Sullivan discloses an expense being a closing cost or producing a closing cost. Because the prior art does not disclose every element of these claims, Applicants respectfully request reconsideration and allowance of claims 5 and 9.

**Dependent claim 11**

Claim 11, which depends from claim 1, is allowable for at least the reasons provided with respect to claim 1 and additionally because it requires that the payment includes interest. The Office action alleges that this limitation is met by Sullivan disclosing that the plurality of options includes more than two options, Office action at 10, but this is not what claim 11 requires. Because the Office action has failed to establish a *prima facie* case of alleged obviousness of claim 11, Applicants respectfully request reconsideration and allowance of claim 11.

**Dependent claim 44**

Claim 44, which depends from claim 43, is allowable for at least the reasons provided with respect to claim 43 and additionally because it requires that the expense payment comprise interest. The Office action admits that Sullivan does not disclose this limitation and cites col. 5, ll. 20-40 and col. 6, ll. 42-67 of Forward for the alleged disclosure, but Applicants respectfully maintain that these cited portions say nothing about interest. As the cited art, singly or in combination, fails to disclose all of the claimed limitations, Applicants respectfully request reconsideration and allowance of claim 44.

**Dependent claims 6 and 10**

Claims 6 and 10, which depend ultimately from claims 1 and 8, respectively, are allowable for at least the reasons provided with respect to claims 1 and 8 and additionally

because they require the expense be a down payment. The Office action admits that Sullivan fails to disclose this limitation and cites Hastings for the alleged disclosure, but none of the cited portions of Hastings disclose that the expense being credited or paid is a down payment. Instead, the cited portion of Hastings discloses only that it allows a person “to create *theoretical* offer scenarios to *accurately estimate* their monthly payment and cash down payment.” Hastings, col. 15, ll. 41-43 (emphasis added). Thus, the cited art, singly or in combination, fails to disclose all of the elements of claims 6 and 10, such that a *prima facie* case of unpatentability has not been established. Applicants, therefore, respectfully request reconsideration and allowance of claims 6 and 10.

**Dependent claims 12-22, 35 and 57-58**

Claims 12-22 and 57-58 depend from various different independent claims and are allowable for at least the reasons provided with respect to those independent claims and additionally because they require that the payment for the expense is one or more selections from among a plurality of options. The Office action admits that Sullivan does not disclose these elements and cites Johnson for their alleged disclosure, but this argument ignores the fact that Sullivan teaches away from the proposed modifications, regardless of what Johnson may or may not disclose. Because the cited art, singly or in combination, neither discloses nor would have made obvious each of these claims, Applicants respectfully request reconsideration and allowance of claims 12-22 and 57-58.

**Dependent claim 23**

Claim 23, which depends from claim 8, is allowable for at least the reasons provided with respect to claim 8 and additionally because it requires the payment include interest. The Office action admits that Sullivan and Forward do not disclose these elements, citing Pettit for their

alleged disclosure, but Pettit does not disclose a payment for a mortgage expense associated with card activity that comprises interest. As the cited art, singly or in combination, does not disclose all of the elements of claim 23, Applicants respectfully request reconsideration and allowance of claim 23.

**35 U.S.C. § 102**

Claim 56 stands rejected under Section 102 as allegedly anticipated by Sullivan. Claim 56 has been canceled, rendering this rejection moot. Claims 59 and 61 have been amended to remove dependencies from canceled claim 56.

**Conclusion**

For at least the foregoing reasons, Applicants respectfully maintain that claims 1-55 and 57-62 are patentable over the cited art. If the Examiner believes it would help to advance prosecution, the undersigned would welcome the opportunity to discuss the above amendment in a telephone interview and can be reached at (312) 201-0011.

Respectfully submitted,

Dated this 1<sup>st</sup> day of July, 2011.

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